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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,705	06/18/2001	Mitchell James Hubert	04027.00008	1042
22910	7590	10/22/2003	EXAMINER	
BANNER & WITCOFF, LTD. 28 STATE STREET 28th FLOOR BOSTON, MA 02109-9601			MEDLEY, MARGARET B	
			ART UNIT	PAPER NUMBER
			1714	11
DATE MAILED: 10/22/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-1

# Office Action Summary

Application No.

09/883,705

Applicant(s)

HUBERT ET AL.

Examiner

Margaret B. Medley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 24-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

### DETAILED ACTION

This office action is in response to paper No.10 dated July 14, 2003.

The pending claims of record are claims 1-28.

Claims 1, 5, 8-13, 16 and 21-23 were amended and claims 24-28 were added.

1. Newly submitted claims 24-26 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: a fire fighting system and systems for evaluating a fire fighting composition wherein each systems comprises various means that are not required by the fire fighting foam concentrates, fire fighting compositions and methods of evaluating a fire fighting composition. The invention are distinct, each from the other because of the above reasons, it would place an undue burden on the office to search both inventions and because of the following reasons:

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for

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prosecution on the merits. Accordingly, claims 24-26 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6, 7 and 11-23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Malinin SU 1,373,406.

Malinin teaches fire fighting foam concentrates, aqueous diluent compositions thereof, method of fighting fire with said compositions and methods of evaluating a fire fighting composition wherein said composition comprises a foamable fire fighting agent, a glycol ether and water soluble dye that anticipate the instant claims, note the English abstract.

Claims 1, 6, 7 and 11-23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Biller WO 97/43,012.

Biller teaches fire fighting foam concentrates, aqueous diluent's compositions thereof, method of fighting fire with said compositions and methods of evaluating a fire fighting composition wherein said compositions comprises a foamable fire fighting agent, a glycol ether and water soluble dye that anticipates the instant claims, note page 5, lines 13-29 and page 6, lines 1-27.

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-6 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malinin SU 1,373,406.

Malinin further teaches dissolving of the nonionic surfactant in halo-hydrocarbon, note the English Abstract.

It would be obvious to the artisan in the art that the resultant mixture of surfactant in a halo-hydrocarbon would produce a fluorosurfactant-based foam which may be alcohol resistant or non-alcohol resistant or that the resultant mixture may further comprise a hydrocarbon based foam that render the instant claims obvious.

7. Claims 2-6 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biller WO 97/43,012 in view of Stearn 5,124,363.

Applicant further claims a fluorosurfactant-based foamable fire fighting agent that is optionally alcohol resistant or that is non-alcohol resistant, or a hydrocarbon based foamable fire fighting agent (FFA) wherein Biller is silent to said teachings.

It would be obvious to the artisan in the art to add the fluorosurfactant based foamable (FFA) that is optional alcohol resistant or non-alcohol resistant, or hydrocarbon base of Stearn to the FFA to render the instant claimed FFA obvious.

8. Stearn teaches aqueous based foams comprising fire retardant, dyes, pigment as optional components, note column 3, lines 19-20; that the foam can be visually

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perceptible by a dye, column 4, lines 49-50; that the surfactants may be hydrocarbon based or fluorosurfactant based, note page 6, line 45 to page 7, line 20; that optional components include dye, pigments and flame retardants, column 9, lines 47-48; Examples 2 and 3 of column 11 and Example 13 of column 16. Thus Steam provides the motivation to further add fluorosurfactant-based foams that is optionally non-alcohol resistant or that is alcohol resistant to the (FFA) of Biller that render the instant claims obvious.

9. Applicant's arguments filed July 14, 2003 have been fully considered but they are not persuasive.

With respect to applicant's allegation that the invention is especially useful when the diluent is sea water or water with a high electrolyte or high dissolved solids content is irrelevant in that the said feature is absence from the pending claims of record.

Applicant's argues that Malinin suggests a binary rather than proportional spectral indicator and that Biller lacks purposes for the food coloring property indicator. The said arguments are irrelevant in that Malinin teaches a fire fighting foam concentrate comprising a foamable fire fighting agent, a water-soluble and glycol ether, a composition comprising the same methods for evaluating the said composition and a method for fighting a fire with said composition that anticipates the instant pending claims 1, 6-7 and 11-23.

The argument that claim 1 of Biller lacks teaching to a water-soluble dye to provide a spectral property of a fire fighting mixture comprising the fire fighting foam concentrate and a diluent being substantially proportional to the concentration of fighting

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agent in the fire fighting foam mixture is irrelevant. The spectral property is a desired feature with a diluent, wherein claim 1 is a concentrate lacking teaching to a diluent.

It is further noted that claims 11, 12, 13, 21 and 22 lack teachings to any relative proportion for any of the component and thus the added spectral property would be inherently present in the concentrates, compositions and methods of the claims of Malinin and Biller that anticipate the instant claims. The features of claims 16 and 20 would also be anticipated by the teachings of Biller.

The teachings for fluorosurfactant base foamable (FFA) of Stearn with the teachings of Biller and Malinin render obvious instant pending claims 2-6 and 8-10 because the said FFA are conventionally used in FFA compositions.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original

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presentation for prosecution on the merits. Accordingly, claims 24-26 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 703-308-2518. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

M. Medley/lap

October 9, 2003

*Margaret B. Medley*  
MARGARET MEDLEY  
PRIMARY EXAMINER